

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed January 28, 2008. In the Office Action, the Examiner notes that claims 1, 3-9, 14, 18, 19, 23, 24, 28-32, 37, 40-43, 45-50, 52-56 and 58-64 are pending and rejected. However, Applicants submit that it appears that the Examiner inadvertently left out claim 34, which Applicants believe is also still pending. The Applicants herein amend claim 30. Support for the amendment may be found in the Applicants' specification on at least page 34, lines 3-10. The Applicants also amend claim 34 to correct informalities. Specifically the inadvertent period in the claim was amended to a comma.

In view of the following discussion, Applicants submit that all of the claims pending in the application are patentable under 35 U.S.C. §§112 and 103.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

I. REJECTION OF CLAIMS 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52-56 AND 58-64 UNDER 35 U.S.C. § 112

The Examiner has rejected claims 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52-56 and 58-64 under 35 U.S.C. §112, ¶1, as failing to comply with the enablement requirement. Applicants note that it appears that the Examiner has inadvertently failed to include pending claim 54. Therefore, Applicants assume that the Examiner meant to include claim 54 within this rejection and will proceed as such. Regardless, the rejection is traversed.

The Applicants note the statements made in the response dated February 1, 2005 stating that manufactures of set top terminals did not manufacture workstations, and workstations and computer OEM manufacturers did not produce set top terminals as they are completely distinct industries. However, the Applicants respectfully submit

that those arguments are not in conflict with the declaration submitted on November 14, 2007.

The issue under 35 U.S.C. § 112, paragraph 1, is whether or not the enablement requirement is satisfied. The Applicants respectfully submit that, as supported by the Applicants declaration, one skilled in the art would know how to construct an insertable hardware upgrade card for a set top terminal that is modeled after the PCMCIA standards used for computers. The Applicants do not necessarily suggest that the hardware upgrade is a PCMCIA card, but rather that one skilled in the art would know how to construct a hardware upgrade card insertable into a set top terminal based on the PCMCIA standards.

Moreover, the Examiner notes the Applicants' specification discusses that either a serial or parallel interface may be used to make the electrical connection between the set top terminal and the insertable hardware upgrade card. (See e.g., Applicants' specification, p. 37, ll. 8-26). The Applicants respectfully submit that simply because the Applicants' specification does not specify which connection (i.e. serial or parallel) is used does not render the invention non-enabling. Even as noted by the Examiner, the specification states "serial or parallel." Consequently, either connection would enable the invention. In other words, the Applicants' specification in fact provides two separate enabling embodiments that satisfy the enablement requirement under 35 U.S.C. §112, paragraph 1.

Therefore, in addition to arguments previously submitted and in view of the additional arguments present above, the Applicants respectfully submit that the claims fully satisfy the requirements of 35 U.S.C. § 112, first paragraph and respectfully request the rejection should be withdrawn.

II. REJECTION OF CLAIMS 30-32, 34, 37 AND 40-41, UNDER 35 U.S.C. § 103

The Examiner has rejected claims 30-32, 34, 37 and 40-41 as being obvious under 35 U.S.C. §103 over Palazzi (U.S. Patent 5,327,554) in view of Banker (U.S. Patent 5,357,276) and Reiter (U.S. Patent 4,751,578). Applicants respectfully traverse the rejection.

The Office Action fails to establish a *prima facie* case of obviousness, because the combination of Palazzi, Banker and Reiter fails to teach or suggest all the claim elements. Specifically, Palazzi, Banker and Reiter fail to teach or suggest a hardware upgrade for upgrading the television terminal, wherein said hardware upgrade comprises a hardware upgrade microprocessor for processing a subscriber's interactive input received from the television terminal microprocessor via the interface to the hardware upgrade microprocessor and generating a response to said subscriber's interactive input to be sent back from the hardware upgrade microprocessor back to the television terminal microprocessor for display, as positively claimed by the Applicants' independent claim 30. The Examiner concedes that Palazzi and Banker fail to teach or suggest a hardware upgrade. (See Office Action, p. 7, ll. 3-5). However, the Examiner asserts that Reiter bridges the substantial gap left by Palazzi and Banker.

The Applicants respectfully submit that Reiter fails to bridge the substantial gap left by Palazzi and Banker because Reiter also fails to teach or suggest a hardware upgrade for upgrading the television terminal, wherein said hardware upgrade comprises a hardware upgrade microprocessor for processing a subscriber's interactive input received from the television terminal microprocessor via the interface to the hardware upgrade microprocessor and generating a response to said subscriber's interactive input to be sent back from the hardware upgrade microprocessor back to the television terminal microprocessor for display. The Applicants respectfully submit that Reiter only teaches that a port may have connected to it a telephone link or a magnetic card or floppy disk. (See Reiter, col. 4, ll. 29-39; FIG. 1 and 2). However, Reiter is silent as to teaching or suggesting that these external peripherals contain a separate microprocessor that communicates with a microprocessor of the terminal. As a result, the telephone link or magnetic card or floppy disk cannot provide the full functionality of the hardware upgrades as taught by the Applicants' invention.

As such, Applicants submit that claim 30 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Claims 31-32, 34, 37 and 40-41, depend, either directly or indirectly, from independent claim 30 and recite additional features thereof. As such, and for at least the same reasons discussed above, Applicants submit that these dependent claims also fully satisfy the

requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the rejection should be withdrawn.

CONCLUSION

Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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